

**REMARKS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

**Status of Claims:**

Claims 2 and 7 are currently being canceled.

Claims 1, 6 and 11 are currently being amended.

Claim 16 is currently being added.

This amendment and reply amends, adds and cancels claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending, canceling and adding the claims as set forth above, claims 1, 3-6 and 8-16 are now pending in this application.

**Objection to the Drawings:**

In the final Office Action, the drawings were objected to because “the determining step during a printing job receiving process in the receiving section must be shown or the feature(s) canceled from the claims(s).” Due to the cancellation of that feature from claims 1, 6 and 11, the objection to the drawings has been rendered moot.

**35 U.S.C. § 112, First Paragraph Rejection:**

In the final Office Action, claims 1, 6 and 11 were rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Due to the amendments made to claims 1, 6 and 11 to remove the feature from those claims that was alleged in the Office Action to lack written description support, this rejection has been overcome.

**35 U.S.C. § 112, Second Paragraph Rejection:**

In the final Office Action, claims 2 and 7 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, for the reasons set forth on page 4 of the Office Action. Due to the cancellation of claims 2 and 7, this rejection is now moot.

**Comments re: Claims 11-13:**

Applicant notes with appreciation that claims 11-13 are not rejected over any art of record.

**Claim Rejections – Prior Art:**

In the final Office Action, claims 1-3, 6-8 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Patent Publication No. 2000-159391 to Chori in view of U.S. Patent No. 6,332,170 to Ban; claims 4 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chori and Ban and further in view of U.S. Patent No. 6,452,694 to Eisenberg et al.; claims 5 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chori and Ban and further in view of U.S. Patent No. 6,169,863 to Osari; and claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Chori and Ban and further in view of U.S. Patent No. 6,930,796 to Matsuura et al. These rejections are traversed with respect to the presently pending claims under rejection, for at least the reasons given below.

In Chori, if the size of an image to be printed is special (i.e., a non-standard size image), first of all, the size of a preset sheet is compared with the image size. Then, if the sheet size is larger than the image size, the special-sized image is printed on the sheet on condition that this sheet is the minimum-sized sheet of standard-sized sheets. In the case of sheets being other than the above, a warning message will be displayed.

That is, in Chori, even if printing to be performed is determined as special printing, the printing job will be executed if a predetermined condition is met. In addition, Chori individually judges whether printing can be performed for each image, and a printing job that includes special printing is not handled as a whole, in contrast to the presently claimed invention.

In particular, in the presently claimed invention, if the received printing job includes special printing, a list of the printing jobs is displayed and the job selected by a user is executed. In other words, a printing job that includes special printing not selected by a user will not be automatically executed as is done in the system of Chori.

Further, as shown in Figure 3 of Ban, Ban discloses a printer in which printing jobs received from each terminal are separately stored as an “ordinary job” and a “manual feed

job”, and that the ordinary job is basically executed, and the manual feed job is executed only when a manual button 32 is pressed. A CPU 110 of the printer identifies the paper feed designation information of the received print jobs and sorts them out to an ordinary job and a manual feed job (See Figure 6, item #122 of Ban).

Therefore, in the printer of Ban, when a printing job is to be executed in the case where the first page to be printed is a tab paper sheet and the second and subsequent pages to be printed are normal paper sheets, it is necessary to execute this job as the ordinary job and the manual feed job at different timings. That is, in such a case, it is necessary to perform an input operation for executing a printing job on the first tab paper sheet and another input operation for executing the printing job on the second and subsequent pages of normal paper sheets, separately (i.e., perform input operations twice).

In contrast, in the presently claimed invention, when the printer receives a printing job, it is determined whether a page index of each page or a job index of the printing job includes information on special printing, and temporarily suspends the printing job which includes the information on special printing in the page index or the job index before executing it at suitable timing. That is, in the presently claimed invention, it is possible to handle a printing job which includes printing on a tab paper sheet and on normal paper sheets as one job. Accordingly, it is unnecessary to perform input operations twice for performing two types of printing included in one printing job, as required in the device of Ban.

The final Office Action also asserts that the invention of present claims 1-3, 6-8 and 14 is easily conceivable in view of the combination of the two cited references (Chori and Ban) stated above. However, as discussed above, since the inventions described in the two references have totally different object and operation and advantage from the presently claimed invention and from each other for that matter, there is no motivation for combining the two cited references. In addition, even if the two references could be combined (which Applicant does not feel would be done by one skilled in the art), it would not have been easy to derive the present invention.

Accordingly, claims 1-3, 6-8 and 14 are patentable over the combination of Chori and Ban.

With respect to the rejection of claim 4 based in part on the teachings of Eisenberg, that reference discloses printing on tab media formed of a small piece of paper, and it does

not disclose printing on a "tabbed paper" like the tab paper sheet of the presently claimed invention.

Therefore, claim 4 is patentable over the combination of the cited art of record.

With respect to the rejection of claim 5 based in part on the teachings of Osari, that reference discloses that an operation screen, such as shown in Figure 7(c) of Osari, is displayed at a timing that sheets are set to a manual feed tray, whereby setting of the size of the sheets is accepted. Osari also discloses that, once the size setting has been completed, changing of the size of the sheets in the manual feed tray is prohibited until the ongoing printing job is completed.

However, Osari does not in any way disclose the displaying of the absence of a special paper sheet when a printing job which includes printing on a special paper sheet is selected but there is no such special paper sheet.

Therefore, claim 5 is patentable over the combination of the cited art of record.

**New Claim:**

New claim 16 has been added to recite additional features that are believed to provide an additional basis of patentability for that claim, beyond the reasons given above with respect to its base claim 1.

**Conclusion:**

Since all of the issues raised in the final Office Action have been addressed in this Amendment and Reply, Applicant believes that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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